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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,864	12/24/2003	Hideyuki Nojiri	246871US3DIV	9345
22850 7590 04/20/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER DESAI, ANISH P	
			ART UNIT	PAPER NUMBER
			1771	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		04/20/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/20/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/743,864

Applicant(s)

NOJIRI, HIDEYUKI

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 01/25/07 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/25/07 has been entered.

2. Claims 1-19 are cancelled. Claims 20-38 are newly added claims.

3. The objections to claims 3 and 5 are moot because these claims are cancelled.

4. The 112 rejections of claim 10 are moot because said claim is cancelled.

However, a new 112 rejection is made for claims 20-38.

5. The art rejections of claims 1-19 are moot because said claims are cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 24-27 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. With respect to claim 24, Applicant's specification discloses that the string member 31 is covered up by a pair of sheets 32 and 32 (specification page 18 lines 4-7, lines 12-15, lines 16-18, and Figures 12 and 14).

These sheets are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188

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USPQ 356 (CCPA 1976). Since claims 25-27 depend from a rejected claim 24, these claims are rejected as well.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 20-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language appears to be internally inconsistent. For example, claims 20, 24, and 28 recite "straight side edges of said surfaces extending along the whole longitudinal direction connected to each other, each of said straight side edges of the first and second surface parallel to each other". How can two straight side edges be parallel to each other yet connected to each other? Further, claim 32 requires that straight side edges of the first and second surfaces be parallel to each other, claim 32 depends from claim 28, which already recites this limitation. Thus, claim 32 fails to further limit independent claim 28. For purpose of the examination, any reference disclosing an elongated tape (e.g. rectangular shape) or a string will read on the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 20-23, 28-30, 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hodgson (US 3,645,835).

The recitations “a double eyelid forming article of manufacture for forming a fold on an eyelid of a user”, “configured to be adhered onto an eyelid in a stretched state in a longitudinal direction”, “a layer of adhesive configured to adhere to an eyelid”, “adhered to the eyelid”, “unstretched state of the tape member to form the double eyelid”, “to form a fold on the eyelid...fold by breaking into the eyelid” are related to an intended use of the claimed article (i.e. tape member or string member). It is the Examiner's position that if the structure and composition of the prior art article is same as claimed by the Applicant's article, then the prior art article is capable of functioning the intended use as presently claimed. Any reference disclosing an elongated tape member that is resiliently stretchable and has an adhesive will read on claims.

Hodgson teaches adhesive materials for use on animal bodies especially human bodies for surgical, dermatological or cosmetic use. The examples include surgical drapes, adhesive dressings, strips and sheets, and eyeliners (Column 2. lines 74-75, Column 3. lines 1-5). Additionally, according to Hodgson another preferred use of the present invention is in surgical drapes. These are large flexible sheets, which are

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provided with a continuous layer of adhesive on at least a part only of one surface (column 7, lines 64-67). The adhesive drape of Hodgson as shown in Figure 7 has a backing layer 2 having an adhesive coating 4 on the surface of the backing layer. Further, the adhesive 4 is covered by a protector 6 (column 10, lines 27-31). The backing layer 2 of Hodgson is preferably formed of a polyurethane film (column 8, lines 5-6). At column 5, lines 69-74, Hodgson discloses Estane 5701 and 5702 brand thermoplastic polyurethane films, which is a polyurethane elastomeric film as evidenced by US 2007/0066185A1 to Felipe (paragraph 0058). Further, Hodgson teaches a use of elastic backing material (column 10, lines 38-39). The backing layer 2 of Hodgson having an adhesive coating 4 is equated to a resiliently stretchable elongate tape member having a layer of adhesive as required by claims 20 and 28. Further, with regards to claims 23 and 28, Hodgson teaches that where only a part of one surface is coated, the adhesive coated area may be varied with the design of the drape and a film or release-coated protector is generally applied to the adhesive-coated area. This protector is removed when it is desired to use the drape. Generally two uncoated margins are provided to enable the protector to be easily removed (column 7, lines 68-73). Further, Hodgson teaches that two edges 24 of the backing material 2 are left uncoated (column 10, lines 31-32). This disclosure of Hodgson reads on "holding portions having no adhering property on the tape member at both ends thereof configured to be held by fingertips" (claim 23) and "a pair of holding portions at both longitudinal ends thereof configured to be held by fingertips" (claim 28).

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As previously noted, the recitations for forming a fold on an eyelid of a user", "configured to be adhered onto an eyelid in a stretched state in a longitudinal direction", "a layer of adhesive configured to adhere to an eyelid", "adhered to the eyelid", "unstretched state of the tape member to form the double eyelid", "to form a fold on the eyelid...fold by breaking into the eyelid" are related to an intended use of the claimed article (i.e. tape member or string member). The backing layer of the surgical drapes of Hodgson as previously noted is formed of elastomeric polyurethane and has an adhesive coating on one surface of the backing. Additionally, as previously noted Hodgson discloses elastic backings. Therefore, it is the Examiner's position that the product of the Hodgson's invention is similar in structure and composition as claimed by the Applicant's tape member, thus the product of Hodgson is capable of functioning as stated in the aforementioned claim recitations.

9. Claims 24-28, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Rollins et al. (US 5,340,648).

As previously noted the recitations "a double eyelid forming article of manufacture for forming a fold on an eyelid of a user", "configured to be adhered onto an eyelid in a stretched state in a longitudinal direction to form a double eyelid", "adhesive configured to adhere to the eyelid", "stretched in a longitudinal direction, and adhered to the eyelid", "string member allows an amount of recoil back to the unstretched state of the string member to form the double eyelid", "length sufficient to form a fold on the eyelid and a width sufficient to form the fold by breaking into the eyelid when the resiliently stretchable string member is held at both longitudinal ends,

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stretched in the longitudinal direction, and pressed and adhered to the eyelid.” are related to an intended use of the claimed article (i.e. tape member or string member). It is the Examiner’s position that if the structure and composition of the prior art article is same as claimed by the Applicant’s article, then the prior art article is capable of functioning the intended use as presently claimed. Any reference disclosing a resiliently stretchable string member having a layer of adhesive provided on at least at the center length of the first/or second surfaces of the string member will read on claims.

Rollins teaches a threadlike or ribbonlike elastic strand is provided with a substantially continuous filament of adhesive helically wrapped around the elastic strand (abstract). The elastic strand of Rollins as shown in Figures 1-4 has arcuate upper and lower surfaces. Further, elastic strand of Rollins as shown in Figure 1 has no adhesive at both ends, which reads on holding portions having no adhering property on the string member at both ends thereof configured to be held by fingertips. The elastic strand of Rollins reads on the string member as presently claimed.

As previously noted, the recitations “a double eyelid forming article of manufacture for forming a fold on an eyelid of a user”, “configured to be adhered onto an eyelid in a stretched state in a longitudinal direction to form a double eyelid”, “adhesive configured to adhere to the eyelid”, “stretched in a longitudinal direction, and adhered to the eye lid”, “string member allows an amount of recoil back to the unstretched state of the string member to form the double eyelid”, “length sufficient to form a fold on the eyelid and a width sufficient to form the fold by breaking into the eyelid when the resiliently stretchable string member is held at both longitudinal ends,

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stretched in the longitudinal direction, and pressed and adhered to the eyelid." are related to an intended use of the claimed article (i.e. tape member or string member).

The elastic strand of Rollins is inherently resiliently stretchable and has an adhesive layer on at least at the center of the length of the first and/or second surface as required by the claims. Therefore, the string member of Rollins is capable of functioning as stated in the aforementioned recitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,645,835) in view of Clavin (US 4,653,483).

The invention of Hodgson is previously disclosed. Hodgson is silent as to teaching of a release sheet having a breaking point to be broken when being stretched is adhered on one or both of the surfaces of the elongate member. However, Clavin teaches cosmetic adhesive tape strips comprising a thin pliable transparent backing material and an adhesive carried on the opposite side surface of the backing material (Column 2, lines 14-17). Clavin further discloses a split peel-off liner 48 with an overlap 56 such that the liner can be split in the middle and removed from the adhesive when the strip is attached to the skin of an upper eyelid (Column 5, lines 1-5). The split peel off liner of Clavin 48 reads on the claimed release sheet having a breaking point. Thus,

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it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the split peel off liner of Clavin in the invention of Hodgson, motivated by the desire to protect the underlying adhesive layer. Regarding claim 38, according to Hodgson the protector, when used, may be a smooth-release coated paper, e.g. a silicone-release coated paper (column 6, lines 70-72).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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